

REMARKS

Reconsideration and allowance are respectfully requested.

Claims 34, 41-46 and 53-57 are pending.

The amendments are supported by the original disclosure and, thus, no new matter has been added (e.g., page 8, lines 18-19, of the specification). If the Examiner should disagree, however, he is respectfully requested to point out the challenged limitation with particularity in the next Action so support may be cited in response.

35 U.S.C. 112 – Written Description

The specification must convey with reasonable clarity to persons skilled in the art that applicant was in possession of the claimed invention as of the filing date sought. See *Vas-Cath v. Mahurkar*, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). The description includes "words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention." *Lockwood v. American Airlines*, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). But the Patent Office has the initial burden of presenting evidence or a reason why persons of ordinary skill in the art would not have recognized such a description of the claimed invention in the original disclosure. See *In re Gosteli*, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989).

Claims 34-57 were rejected under Section 112, first paragraph, because it was alleged that they contain "subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Applicants traverse because expression of a viral gene in a prepackaging cell is clearly taught by the specification.

Claims 35-40 and 47-52 were rejected under Section 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicants traverse because claims 35-40 and 47-52 are canceled.

Withdrawal of the Section 112, first paragraph rejections, is requested because the specification conveys to a person skilled in the art that Applicants were in possession of the claimed invention as of the filing date.

35 U.S.C. 112 – Definiteness

Claims 34-57 were rejected under Section 112, second paragraph, as being allegedly "indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Applicants traverse because "foreign gene" has been replaced by --gene encoding a viral structural protein--.

Applicants request withdrawal of the Section 112, second paragraph, rejection because the pending claims are clear and definite.

Conclusion

Having fully responded to all of the pending objections and rejections contained in the Office Action (Paper No. 200440515), Applicants submit that the claims are in condition for allowance and earnestly solicit an early Notice to that effect. The Examiner is invited to contact the undersigned if any further information is required.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:

Gary B. Tanigawa
Reg. No. 43,180

1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100